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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,767	01/19/2002	Hirokatsu Bannai	M 6741 HST PCT/US	7612

7590

02/21/2003

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EXAMINER

BARR, MICHAEL E

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 02/21/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/049,767

Applicant(s)

BANNAI ET AL.

Examiner

Michael Barr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Preliminary Amendment***

1. The examiner acknowledges the addition of Claims 5-10. Claims 1-10 are pending.

### ***Priority***

2. It should be noted that there is a discrepancy in the priority date of the international application PCT/US00/22335. In both the applicant's submitted form PTO-1390 and the Office's form PTO-903, the filing date of the international application PCT/US00/22335 is listed as 8/14/2000. However, the applicant's oath, first line of the specification, and the WIPO publication of PCT/US00/22335 have the filing date of PCT/US00/22335 as 8/16/2000. It appears that 8/16/2000 is the correct filing date of the international application PCT/US00/22335 and thus this national stage filing is being prosecuted with the understanding that PCT/US00/22335 has a filing date of 8/16/2000. Please comment if this is not correct.
3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 8/16/1999. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b). There is no copy of the Japanese application 11-230060 in the present application. It is requested that the applicant submit a copy of the certified copy of the Japanese application.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/05066 in view of Knaster et al.

WO 00/05066 teaches phosphate conversion coating a metal surface, including steel, zinc-plated steel, and magnesium and aluminum alloys, by pretreating the metal with a surface conditioner, which has the claimed material and concentration requirements and then further phosphating with any typical phosphate conversion coating solution (Pg. 5, line 1-Pg. 6, line 7; Pg. 11, lines 6-18). WO 00/05066 does not teach the particularly claimed conversion coating solution. However, since WO 00/05066 teaches that any typical phosphate conversion coating can be used, it would have been obvious to one skilled in the art to use a conventional phosphate conversion coating solution in WO 00/05066, with the expectation of achieving the desired conversion coating results. Knaster et al. teaches nickel-free phosphating a steel, zinc-plated steel, or aluminum alloy substrate by pre-treating the substrate with a conditioner, and then phosphating with a nickel-free, aqueous solution containing zinc, phosphate, and cobalt ions in the claimed amounts (Abstract; Col. 5, lines 57-Col. 6, line 8, Col. 9, lines 1-7). The phosphating composition taught in Example II includes a conversion accelerator. Knaster et al. also teaches that the phosphating solution include a buffering agent which provides fluoride ions (Col. 7, lines 25-33; Table B), which reads on claim 9. It would have been obvious to one skilled in the art to

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modify the WO 00/05066 process by using the phosphate conversion coating solution of Knaster et al., with the expectation of providing the desired conversion coating, since Knaster et al. is a typical phosphate conversion coating solution for conditioned metal substrates.

\*\*\*\*\*Please note that applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-3 and 12 of U.S. Patent No. 6,478,860 in view of Knaster et al. Claims 1-3 and 12 of U.S. Patent No. 6,478,860 teach conditioning a metal surface with a surface conditioner, which has the claimed material and concentration requirements, prior to phosphating with a phosphate conversion coating solution. Claims 1-3 and 12 of U.S. Patent No. 6,478,860 do not teach further conversion coating the conditioned metal with the particularly claimed conversion coating solution. Knaster et al. teaches nickel-free phosphating a steel, zinc-

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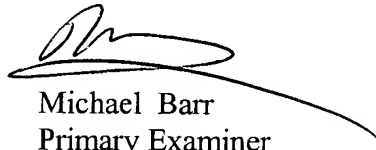
plated steel, or aluminum alloy substrate by pre-treating the substrate with a conditioner, and then phosphating with a nickel-free, aqueous solution containing zinc, phosphate, and cobalt ions in the claimed amounts (Abstract; Col. 5, lines 57-Col. 6, line 8, Col. 9, lines 1-7). The phosphating composition taught in Example II includes a conversion accelerator. Knaster et al. also teaches that the phosphating solution include a buffering agent which provides fluoride ions (Col. 7, lines 25-33; Table B), which reads on claim 9. It would have been obvious to one skilled in the art to modify the process of Claims 1-3 and 12 of U.S. Patent No. 6,478,860 by using the phosphate conversion coating solution of Knaster et al., with the expectation of providing the desired conversion coating on the conditioned metal of Claims 1-3 and 12 of U.S. Patent No. 6,478,860, since Knaster et al. is a typical phosphate conversion coating solution for conditioned metal substrates. Furthermore, it would have been obvious to one skilled in art to use a steel, zinc-plated steel, or aluminum alloy substrate in Claims 1-3 and 12 of U.S. Patent No. 6,478,860, since such metal substrate are typical for such conditioning and phosphating, as illustrated by Knaster et al.

*Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Barr whose telephone number is 703-305-7919. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 or 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Michael Barr  
Primary Examiner  
Art Unit 1762

MB  
February 6, 2003